

Application No.: 09/647748

Case No.: 54030US008

REMARKS

Claims 1-4 are pending. Claim 4 has been canceled. Claims 1 and 2 are amended. Claim 5 has been added.

§ 112 Rejections

Claims 1-4 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has amended claims 1 and 2 with many of the suggestions proposed by the Examiner. However, Applicant has not changed the comprising language to formed of as suggested by the Examiner. The term "comprising" is well known in the patent art and the Examiner has made no prior art reasoning that the term "comprising" is unavailable to the Applicant. Therefore, the Applicant has maintained the term "comprising" in claim 1, line 2 and in claim 2, line 3.

Applicant has canceled claim 4 and added new claim 5. Support for new claim 5 can be found, for example, in the specification at page 7, lines 6-7.

In summary, Applicant submits that the rejection of claims 1-4 under 35 U.S.C. 112, second paragraph, has been overcome, and that the rejection should be withdrawn.

§ 103 Rejections

Claims 1-4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over NITTO DENKO CORP in view of Canary.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

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The Examiner has stated that the Applicant has argued the cited references individually. Applicant would like to reassert that we have not been attacking references individually as stated by the Examiner. The references, as combined, fail to present a prima facie case of obviousness because the references fails to teach that the combination would reasonably be expected to work as a tape backing.

Additionally, the references, as combined, must teach each and every element of the claimed invention. As stated in prior responses, the Examiner has not shown that each and every element of the claimed invention is present in the art of record. No reference teaches the short fibers having a length within the range of about 3 to 20 mm and comprising a material selected from polyvinyl alcohol, polyamide, polyester, polyethylene, polypropylene, polyurethane, polyvinyl chloride, polyvinylidene chloride, polyacrylonitrile, rayon, or combinations thereof. Therefore, the Examiner has not met the burden of showing a *prima facie* case of obviousness.

In summary, the rejection of claims 1-4 under 35 U.S.C. 103(a) as being unpatentable over NITTO DENKO CORP in view of Canary should be withdrawn.

In the event the Examiner continues to reject the claims after the present response, the Applicant respectfully requests an interview on the issues presented prior to any future office action.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

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Date

Respectfully submitted,

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Version with markings to show amendments made:

1. (Three Times amended) A paper backing[,] for supporting a secondary layer, which has a double-layer paper structure comprising a first paper layer and a second paper layer, said first paper layer and said second paper layer each being manufactured from wood pulp and short fibers, the short fibers having a length within the range of about 3 to 20 mm and comprising a material selected from the group consisting of polyvinyl alcohol, polyamide, polyester, polyethylene, polypropylene, polyurethane, polyvinyl chloride, polyvinylidene chloride, polyacrylonitrile, rayon. [or] and combinations thereof, wherein said first layer has a blend[ing] ratio of short fibers to wood pulp larger than the blend[ing] ratio of short fibers to pulp in the second layer.

2. (Three Times amended) An adhesive sheet comprising a paper backing and an adhesive layer provided on one of its surfaces, said paper backing having a double-layer paper structure comprising a first paper layer and a second paper layer, in which said first paper layer and said second paper layer each is manufactured from wood pulp and short fibers, the short fibers having a length within the range of about 3 to 20 mm and comprising a material selected from the group consisting of polyvinyl alcohol, polyamide, polyester, polyethylene, polypropylene, polyurethane, polyvinyl chloride, polyvinylidene chloride, polyacrylonitrile, rayon, [or] and combinations thereof, and said adhesive layer being provided on the surface of said first paper layer having a blend[ing] ratio of short fibers to wood pulp that is larger than the blend[ing] ratio of short fibers to wood pulp of said second paper layer.